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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/342,971 06/29/99 RODRIGUEZ

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023735 TM02/0606
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EXAMINER

LASTRA, D

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/342,971

Applicant(s)

RODRIGUEZ ET AL.

Examiner

DANIEL LASTRA

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

1. Claims 1-4 have been examined.

Specification

2. The disclosure is objected to because of the following informalities:

A. Appendix: 37 CFR 1.96 deals with appendices in Patent Applications and reads in part:

37 CFR 1.96 - Submission of computer program listings.

Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of these rules is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine - independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications in the following forms:

(a) Material which will be printed in the patent. If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) Drawings. The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) Specification.

(I) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) The listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as camera ready copy when a patent is subsequently printed. Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover. When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about $\frac{1}{2}$ in size with two printout sheets being printed as one patent specification page. Any amendments must be made by way of submission of a substitute sheet if the copy is to be used for camera ready copy.

(b) As an appendix which will not be printed. If a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a microfiche appendix. The microfiche appendix will not be part of the printed patent. Reference in the application to the microfiche appendix should be made at the beginning of the specification at the location indicated in § 1.77(c)(2). Any amendments thereto must be made by way of revised microfiche. All computer program listings submitted on paper will be printed as part of the patent.

(1) Availability of appendix. Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such an application is granted or the application is otherwise made publicly available.

(2) Submission requirements. Computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards set forth in the following American National (ANSI) or National Micrographics Association (NMA) Standards (Note: As new editions of these standards are published, the latest shall apply):

Appendix A, which comprises the pages A-1 through A-9 and Appendix B, which comprises the pages B-1 through B-45 are improper appendix. As stated in 37 CFR 1.96 above, an appendix may only contain a computer program listing. Applicant should remove the appendixes and any reference to these appendixes, which appear in the specification (page 1, lines 7-10). Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathus et al (U.S. 5,932,863).

As per claim 1, Rathus et al teach:

“steganographically encoding a print advertisement to hide plural-bit data therein” (see column 5, lines 21-27 and column 6, lines 13-16);

“processing the print advertisement to extract the plural-bit data therefrom” (see column 6, lines 10-35);

“using at least a part of the extracted plural-bit data to direct an internet web browser to a web site that provides consumer information related to a product or service promoted by the print advertisement” (see column 7, lines 61-67 – column 8, lines 1-23). Rathus et al do not explicitly mention an internet web browser. However, Rathus et al system teach that the communication of certain information, such as pricing information or scheduling information, from the server to the user display unit, could easily be transmitted via an inexpensive telephone/modem link (see column 10, lines 40-48). Also, Rathus et al teach that one of the services provided to the customer upon processing the print advertisement to extract the embedded data, is a computer “chat” link. The Internet, to one ordinary skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be a chat room site where customers communicate or chat with each other. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Rathus et al system could provide a computer “chat” link by a telephone/modem link, it would use a web browser and connect to the Internet to provide consumer information related to a product or service. The desirability to do this is to provide users a method where they can obtain product information not matter where they are located.

As per claim 4, Rathus et al teach:

“steganographically encoding a travel photograph to hide plural-bit data therein” (see column 5, lines 21-27, column 6, lines 13-16 and column 7, lines 61-67 – column 8, lines 1-23);

“processing the travel photograph to extract the plural-bit data therefrom” (see column 6, lines 10-35);

“using at least part of the extracted plural-bit data to direct an Internet web browser to a web site that provides travel information useful to a consumer who wishes to visit the location depicted in the photograph” (see column 7, lines 61-67 – column 8, lines 1-23). Rathus et al do not explicitly mention an Internet web browser. However, Rathus et al system teach that the communication of certain information, such as pricing information or scheduling information, from the server to the user display unit, could easily be transmitted via an inexpensive telephone/modem link (see column 10, lines 40-48). Also, Rathus et al teach that one of the services provided to the customer upon processing the print advertisement to extract the embedded data, is a computer “chat” link. The Internet, to one ordinary skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be a chat room site where customers communicate or chat with each other. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that if the Rathus et al system could provide a computer “chat” link by a telephone/modem link, it would use a web browser and connect to the Internet to provide travel information useful to a consumer. The desirability to do this is to provide users a method where they can obtain product information not matter where they are located.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 2 is rejected under 35 U.S.C. 102(e) as being unpatentable by Rathus et al (U.S. 5,932,863).

As per claim 2, Rathus et al teach:

“steganographically encoding a first print advertisement with first data” (see column 5, lines 22-27 and column 6, lines 10-35) ;

“steganographically encoding a second print advertisement with second data” (see column 5, lines 22-27 and column 6, lines 10-35);

“decoding the first and second data when consumers present the first and second advertisements to an optical sensor” (see column 6, lines 10-45 and column 7, lines 21-51); and

“tallying the number of decoded first and second data, respectively, to determine consumer response to the advertisements” (see column 6, lines 31-35).

Claim 3 is rejected under 35 U.S.C. 102(e) as being unpatentable by Fajkowski (U.S. 5,905,246).

As per claim 3, Fajkowski teaches:

“presenting an object within the field of view of an optical sensor device, the object being selected from the list consisting of a retail product, or packaging for a retail product” (see column 15, lines 11-41);

“acquiring optical data corresponding to the object” (see column 15, lines 20-28);

“decoding plural-bit digital data from the optical data” (see column 15, lines 20-28);

“submitting at least some of said decoded data to a remote computer” (see column 22, lines 10-67); and

"determining at the remote computer whether a prize should be awarded in response to submission of said decoded data" (see columns 22-24).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Fridrich et al teach a method of encryption that features the steps of first encrypting a message and then hiding (embedding) it within a digital image carrier.
- DeMont teaches how to hide a message, such as, for example, a copyright notice or other indicium or authorship, in an electronic document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

D.L.

Daniel Lastra
June 4, 2001

Steve Gravini for ew

STEPHEN GRAVINI
PRIMARY EXAMINER